



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,533	12/11/2001	Andrew J. Fish	10559-628001/P11062	4295

8791 7590 03/01/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

CHEN, TSE W

ART UNIT PAPER NUMBER

2116

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,533

Applicant(s)

FISH ET AL.

Examiner

Tse Chen

Art Unit

2116

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment dated February 3, 2006.
2. Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

[a] A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-8 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harmer, US patent 5,835,760 in view of Extensible Firmware Interface Specification – Draft for Review, hereinafter EFIS.

5. In re claim 1, Harmer discloses a system [200] comprising:

- Central processor [col.13, ll.40-41; associated with host].
- A non-volatile memory [rom] coupled with the central processor and storing platform firmware [bios] [col.8, ll.48-49].
- A machine-readable medium [mass memory storage; e.g., 114] coupled with the central processor, the machine-readable medium to be used in initializing the operating environment for the system upon power up [col.13, ll.45-47; expansion bios needed to run devices in operating environment], the machine-readable medium comprising a first set of instructions [128] [col.9, ll.49-54] forming at least a portion of the operating environment [col.9, ll.26-29; to run device], and a second set of instructions [120] [col.9,

Art Unit: 2116

1.40] defining one or more firmware extensions [124] to enable the system to access the first set of instructions [124, a component of 120, accessed 128], wherein the one or more firmware extensions comprise a self-describing media module [col.9, ll.16-29; col.11, ll.34-36; system reads self describing 124 component to access other part of code such as 128 and 134 in order to run device].

6. Harmer did not disclose the details of an extensible firmware interface.

7. EFIS teaches an extensible firmware interface [EFI] comprising data tables having platform-related information [Page. 299, ll.3-7], a loader for an operating environment [Page 9, fig.1-1; Page 104, Section 4.4] and boot and runtime service calls available to the operating environment [Page 1, ll.3-4], wherein the EFI enables extension of platform firmware by loading driver and application images, which when loaded, have access to all EFI defined runtime and boot services [fig.2-1; Page 13, ll.1-3].

8. The motivation for incorporating the External Firmware Interface includes the benefit of abstraction, such that code may be written for a variety of hardware devices without having explicit knowledge of the specifics for each device [EFIS: Page 4, ll.3-5].

9. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate EFI as taught by the EFIS with the system disclosed by Harmer for the benefit of permitting faster and easier development of code for a variety of hardware devices.

10. As to claim 2, Harmer discloses the machine-readable medium comprises a hard disk platter [col.13, ll.47-50].

Art Unit: 2116

11. As to claim 3, Harmer discloses the one or more firmware extensions comprise a file system driver to support a file system format not supported by the platform firmware [col.9, ll.49-54; 132 necessary to run device with 130].

12. As to claim 5, Harmer discloses the central processor comprises a central processing unit housed in a single chip [col.1, ll.31-35].

13. As to claim 6, Harmer discloses a volatile memory [ram] [col.13. l.41]; and a motherboard coupling the volatile memory, the non-volatile memory and the machine-readable medium with the central processing unit [fig.9; motherboard by definition connects the main components of a computer system; although not explicitly mentioned, it is considered inherent to the operation of the system].

14. As to claim 7, Harmer discloses self-describing machine-readable medium [114; col.9, ll.49-54; reads self describing 124 component to access other part of code such as 128 and 134 in order to run device] comprising:

- A first set of instructions [120] in a first portion of the medium [fig.5] [col.9, ll.49-54] defining operations for enabling a machine to access a second set of instructions [128] in a second portion of the medium [fig.5] [col.11, ll.34-36; 124, a component of 120, accesses 128] comprising at least a portion of an operating system [operating data] stored on the machine-readable medium in a format that is unreadable by the machine before the machine loads the first set of instructions [col.9, ll.49-54; reads self describing 124 component to access other part of code such as 128 and 134 in order to run device with 130].
- The second set of instructions [128] [fig.5].

Art Unit: 2116

15. Harmer does not disclose incorporating an extensible firmware interface.

16. EFIS teaches wherein the first set of instructions comprises at least one extensible firmware interface image [EFI] providing a software abstraction enabling access to the second portion of a medium, wherein platform firmware of the machine does not have a mechanism to access the second portion of the medium prior to accessing the EFI image [Page 1, ll.3-4; fig.2-1; Page 13, ll.1-3]

17. The motivation for incorporating the EFI includes the benefit of abstraction, such that code may be written for a variety of hardware devices without having explicit knowledge of the specifics for each device [Page 4, ll.3-5].

18. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate an EFI as taught by the EFIS with the system disclosed by Harmer for the benefit of permitting faster and easier development of code for a variety of hardware devices.

19. As to claim 8, Harmer discloses the first set of instructions comprise one or more extensions to platform firmware capability [col.13, l.63 - col.14, l.2].

20. As to claim 17, Harmer and EFIS disclose each and every limitation of the claim involving the means thereof [machines readable medium relates to mass storage means] as discussed above in reference to claims 1 and 7.

21. In re claim 18, Harmer discloses the mass storage means comprises an optical disk [compact disk] [col.13, ll.47-50].

22. In re claim 19, Harmer discloses the means for extending platform firmware capabilities comprise a file system driver to support file system format not supported by the platform

Art Unit: 2116

firmware [col.9, ll.49-54; reads self describing 124 component to access other part of code such as 128 and 134 in order to run device with 130].

23. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harmer and EFIS as applied to claims 1 and 17 above, and further in view of BIOS Updates, hereinafter BIOSU.

24. Harmer and EFIS disclose each and every limitation as discussed above in reference to claims 1 and 17. Harmer did not disclose a non-volatile memory that comprises a random access non-volatile memory.

25. BIOSU teaches the non-volatile memory comprises random access non-volatile memory [eeprom] [Paragraph 2, ll.5-6].

26. The motivation for using a random access non-volatile memory, in this case an EEPROM, allows for "a ROM that can be erased and re-written" [BIOSU: Paragraph 3, l.3]. This will allow for updates to be made to the BIOS without requiring physical replacement of ROM.

27. Accordingly, it would have been obvious to a person of ordinary skill in the art to modify the device disclosed by Harmer to incorporate a non-volatile random access memory as described by BIOSU for the benefit of providing a circuit housing a BIOS that is more readably modifiable.

28. Claims 9-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harmer and EFIS as applied to claims 7 and 8 above, and further in view of Rakavy et al., US Patent 5978912, hereinafter Rakavy.

29. In re claim 9, Harmer discloses the portion of an operating system comprises operating data that may include, but is not limited to, system configuration information, data, text,

Art Unit: 2116

passwords, or any other information that may provide some purpose during the start-up of the system [col.16, ll.20-24]. Harmer did not disclose explicitly the operating data includes an operating system loader.

30. Rakavy teaches the POST reads a block of data from a predetermined location from the boot device, usually the hard disk or a diskette drive, into memory, and passes control to the program in that data block. This program, known as a bootstrap loader, then loads a larger program into memory. If the larger program is properly loaded into memory the boot program passes control to it. The operating system is then initialized and gains control of the CPU [col.2, ll.27-34].

31. Rakavy provides this as background for the methodology of the typical startup procedure of an IBM compatible personal computer" [col.1, ll.64-66].

32. This standard behavior would accordingly suggest that it would be obvious to a person of ordinary skill in the art that, though Harmer does not specifically mention an operating system or bootstrap loader, his invention would follow this standard startup procedure and provide such a program because it serves an important purpose during the start-up of the system.

33. As to claim 10, Harmer discloses the one or more extensions to platform firmware capability comprise a file system driver to support a file system format used to store at least a portion of the second set of instructions [col.11, ll.34-36; the file system described consists of giving the first portion of the expansion BIOS the ability to find and read the second portion of the expansion BIOS].

Art Unit: 2116

34. As to claim 11, Harmer discloses the one or more extensions to platform firmware capability comprise glyphs that represent a language [col.15, ll.57-62; glyphs are graphical in nature].

35. In re claim 13, Harmer discloses a machine-implemented method for extending platform firmware capabilities [col.8, ll.41-44], the method comprising:

- Loading on a system one or more firmware extensions [col.8, ll.41-44] from a boot media [col.46-47].
- Booting the system [col.13, ll.53-56].
- Loading and running operating data [that] may include, but is not limited to, system configuration information, data, text, passwords, or any other information that may provide some purpose during the start-up of the system from the boot media [col.16, ll.20-24] using the one or more loaded firmware extensions [col.15, ll.49-53], the one of more loaded firmware extensions [124] enabling the system to access the operating data from a portion of the boot media inaccessible to the unextended platform firmware [col.9, ll.49-54; 124 component necessary to access other part of code such as 128 and 134 in order to run device with 130].

36. Harmer did not disclose explicitly the loading and running an operating system loader from the boot media using the one or more loaded firmware extensions.

37. Rakavy teaches the POST reads a block of data from a predetermined location from the boot device, usually the hard disk or a diskette drive, into memory, and passes control to the program in that data block. This program, known as a bootstrap loader, then loads a larger program into memory. If the larger program is properly loaded into memory the boot program

Art Unit: 2116

passes control to it. The operating system is then initialized and gains control of the CPU [col.2, ll.27-34].

38. Rakavy provides this as background for the methodology of the typical startup procedure of an IBM compatible personal computer [col.1, ll.64-66].

39. This standard behavior would accordingly suggest that it would be obvious to a person of ordinary skill in the art that, though Harmer does not specifically mention an operating system or bootstrap loader, his invention would follow this standard startup procedure and provide such a program because it serves an important purpose during the start-up of the system.

40. Harmer and Rakavy do not disclose firmware extensions being compatible with an extensible firmware interface.

41. EFIS teaches an extensible firmware interface [EFI] comprising data tables having platform-related information [Page 299, ll.3-7], a loader for an operating system [Page 9, fig.1-1; Page 104, Section 4.4] and boot and runtime service calls available to the operating system [Page 1, ll.3-4], wherein the EFI enables extension of platform firmware by loading driver and application images, which when loaded, have access to all EFI defined runtime and boot services, the system having an EFI architecture [fig.2-1; Page 13, ll.1-3].

42. The motivation for incorporating the EFI includes the benefit of abstraction, such that code may be written for a variety of hardware devices without having explicit knowledge of the specifics for each device [EFIS: Page 4, ll.3-5]

43. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of invention to render the firmware extensions to be compatible with an EFI as taught by

Art Unit: 2116

the EFIS with the system disclosed by Harmer for the benefit of permitting faster and easier development of code for a variety of hardware devices.

44. As to claim 14, Harmer discloses loading one or more firmware extensions from a boot media during a system boot in such a manner that abstracts a mass storage device containing the boot media [col.13, ll.47- 50]. Harmer does not disclose the method for this abstraction as incorporating a block input/output protocol. Rakavy further teaches POST reads a block of data from a predetermined location from the boot device, usually the hard disk or a diskette drive [col.2, ll.27-29].

45. As to claim 15, Harmer further discloses the one or more firmware extensions comprise a file system driver to support a file system format used to store data on the boot media [col.11, ll.34-36; the file system described consists of giving the first portion of the expansion BIOS the ability to find and read the second portion of the expansion BIOS].

46. As to claim 16, Harmer further discloses: the one or more firmware extensions further comprise glyphs that represent a language [col.15, ll.57-62, glyphs are graphical in nature].

47. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy, Harmer and EFIS as applied to claim 9 above, and further in view of Unicode Technical Report #10, hereinafter UTR.

48. Harmer discloses the general concept of storing information required during the start-up of the system may include a variety of operating data, text, or other information that increases the functionality of the system during the start-up of the system [col.15, ll.54-57]. Harmer did not disclose the inclusion of a Unicode collation module as an extension to a system that may be stored on a mass memory storage device.

Art Unit: 2116

49. However, UTR shows a Unicode Collation Algorithm is a well-known method for providing alphabetic, diacritic and case ordering [Page 2; Section Summary; Paragraph 3, ll.4-6].

50. The motivation behind ordering/collation is that sorted entities are far more searchable than ones that are not.

51. Sorting is a fundamental task in computers and it would be obvious to a person of ordinary skill in the art to modify Harmer to incorporate a Unicode collation algorithm as a method of increasing the functionality of a computer system without increasing the cost of the peripheral device and/or the system [Harmer: col.15, ll.52-53].

Response to Arguments

52. All rejections of claim limitations as filed prior to Amendment dated February 3, 2006 not argued in entirety or substantively in response filed as said Amendment have been conceded by Applicant and the rejections are maintained from henceforth. Any arguments hereinafter related to said rejections of claim limitations will be considered untimely.

53. Applicant's arguments filed February 3, 2006 have been fully considered but they are not persuasive.

54. Applicant alleges that "at least a portion of the operating environment, i.e., an operating system reside on the mass medium". However, Examiner was not able to locate in the original disclosure an explicit definition equating an operating environment to an operating system. As such, Examiner is entitled to broadly interpret an operating environment as comprising an operating system and applications such as the firmware expansion bios needed to operate devices.

Art Unit: 2116

55. Applicant alleges that Harmer does not teach “that the expansion firmware describes how to access other portions of media within the peripheral devices”. Examiner disagrees and submits Applicant’s admission that Harmer “teaches that the expansion firmware enables initialization of the device” [pg. 7 of Remarks dated February 3, 2006] indicates Harmer’s expansion firmware is indeed accessing other portions of the media through the initialization process.

56. Applicant alleges that “a self describing media module... may be used to modularly extend platform capabilities and to minimize non-volatile memory in a data processing system... Harmer [does not] teach this type of media”. Examiner disagrees and submits Harmer does disclose a self describing media module [option rom 124] used to modularly extend platform capabilities to properly initialize and run device; and to minimize non-volatile memory [computer’s rom] by situating the module on the media instead [and read into ram].

57. Applicant alleges that the EFIS “teaches away from Applicants’ invention [that allows the EFI OS loader to remain generic and unmodified and still boot from various non-standard media]... EFIS describe... it is possible to envision other boot media types being added, although these may require OS loader modification if they require use of protocols other than those defined in this document”. Examiner disagrees and submits that the features upon which applicant relies (i.e., EFI OS loader to remain generic and unmodified and still boot from various non-standard media with protocols different from the ones of EFIS) are not recited in the rejected claim(s). Moreover, Examiner was not able to find an explicit definition for non-standard medium in the original disclosure.

Art Unit: 2116

58. Applicant alleges that BIOS Updates “fails to teach or disclose that the system has an extensible firmware interface”. Examiner submits that EFIS, not BIOS Updates, was cited in the combined rejection to teach extensible firmware interface.

59. Applicant alleges that Rakavy does not teach “a system with an EFI architecture where the EFI enables extension of platform firmware...” Examiner submits that EFIS, not Rakavy, was cited in the combined rejection to teach extensible firmware interface.

60. Applicant alleges that Rakavy “teaches away from ... self-describing machine readable medium” with “a bootstrap loader... retrieved during POST from a predetermined location”. Examiner disagrees and submits that the self-describing machine readable medium as recited in the claims is not associated with a bootstrap loader.

61. Applicant alleges that Rakavy does not teach “that these optional hardware devices are self describing, or that they are also contain a portion of the operating system... can be the boot device”. Examiner submits that Harmer, not Rakavy, was cited in the combined rejection to teach those limitations.

62. As such, Applicant’s arguments are deemed not persuasive and the rejections are respectfully maintained.

Conclusion

63. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2116

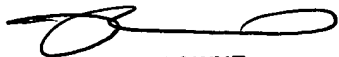
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tse Chen whose telephone number is (571) 272-3672. The examiner can normally be reached on Monday - Friday 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tse Chen
February 15, 2006


LYNNE H. BROWNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100